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Paper No. 10
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12/27/00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Atkinson & Company, Inc.

Serial No. 75/518,824

Diane R. Meyers of Eckert Seamans Cherin & Mellott, LLC for
Atkinson & Company, Inc.

M. Catherine Faint, Trademark Examining Attorney, Law
Office 103 (Michael Szoke, Managing Attorney).

Before Simms, Walters and Rogers, Administrative Trademark
Judges.

Opinion by Rogers, Administrative Trademark Judge:

Atkinson & Company, Inc. has filed an application to
register BENEFIT PARTNERS as a service mark in
International Class 35 for "employee benefits consulting
services."¹ The Trademark Examining Attorney refused
registration under Section 2(d) of the Trademark Act, 15
U.S.C. §1052(d), on the ground that applicant's mark, when

¹ Serial No. 75/518,824, filed July 9, 1998, alleging January 4,
1994 as a date of first use and first use in commerce.

used in connection with the identified services, will be likely to cause confusion or mistake or to deceive, in view of the prior registration of YOUR BENEFITS PARTNER for "insurance agency services, namely the administration of insurance programs for insured groups and individuals; and insurance brokerage services as agent of insurance providers and through independent general agents" in International Class 36.²

When the refusal was made final, applicant appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See In re E.I. du Pont de Nemours and Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In the analysis of likelihood of confusion presented by this case, two key considerations are the similarities of the marks and the similarities of the services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

² Registration No. 1,994,627, issued August 20, 1996, listing November 14, 1994 as date of first use and first use in commerce.

We begin with the services and note that our analysis of the similarity or relatedness of the services must be based on the identifications in the involved application and registration. See Octocom Systems Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990), and Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987). Accordingly, applicant's argument that its services clearly involve cost-cutting or rate reductions for purchasers of the services, while the services of the registrant do not, is inapposite.

Applicant argues that its identification of services is broader than that in the cited registration. We agree, and find that applicant's identified services would include some of the more narrowly identified services of registrant. Specifically, applicant's specimens demonstrate that the range of services it offers includes administration of insurance programs for businesses. Such a service is also encompassed within registrant's "...administration of insurance programs for insured groups...."

In addition, the Examining Attorney has made of record numerous registrations, based on use in commerce of the

marks shown therein, demonstrating that other entities have registered their marks for both employee benefits services and insurance services similar to those of the applicant and registrant.³ Such third-party registrations serve to suggest that the involved services are of a type that may emanate from a single source. See In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993).

Thus, we find unpersuasive applicant's argument that the services are dissimilar because applicant offers a collection of services that is broader than the services offered by registrant. Instead, we find the services overlapping, in part, and otherwise related.

Turning to the marks, we begin by noting that applicant has included a disclaimer of "Benefit" and the cited registration includes a disclaimer of "Benefits." In addition, we note that applicant has made of record copies of third-party registrations for the marks PARTNERS IN BUSINESS, PARTNERS IN TRUST, PARTNERS MEDICARE CHOICE and design, PARTNERS PLUS, WORKCOMP PARTNERS, CAREPARTNERS and HEALTHPARTNERS, all of which were registered by different entities for various insurance and/or benefits programs in

³ In fact, some of the third-party registrations made of record by applicant, to show the weakness of the term "Partners," also demonstrate the relatedness of the involved services.

classes 35 or 36. These registrations are not evidence of commercial use of the marks shown therein, or of the state of the marketplace for the services identified in the registrations. Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992). At most, the registrations are probative that "Partners" is a term that has "appealed to others as a trademark element" in the insurance and benefits field, and that marks incorporating the term may not be particularly distinctive in these fields. See Bost Bakery, Inc. v. Roland Industries, Inc., 216 USPQ 799, 801 n.6 (TTAB 1982). Nonetheless, even if we consider the mark in the cited registration to be a weak mark and entitled to only a narrow scope of protection, it is well-settled that "[e]ven though a mark may be 'weak' in the sense of being a common word in common use as a trademark, it is entitled to be protected sufficiently to prevent confusion as to source from arising." Matsushita Electric Industrial Co., Ltd. v. National Steel Construction Co., 170 USPQ 98, 99 (CCPA 1971).

To distinguish the marks, applicant relies, in part, on the fact that different terms are pluralized in each mark. Applicant also relies on the presence of YOUR in registrant's mark. The differences between the respective marks' plural and singular terms are not significant.

Likewise, the presence of YOUR in registrant's mark is not particularly significant. The marks look and sound very similar. Also, the connotations of the marks are similar. The registered mark, YOUR BENEFITS PARTNER, yields the connotation of a firm or entity which would be the partner of the purchaser of the services, so as to suggest the nature of the relationship between the provider and purchaser of registrant's services. Applicant's mark may be viewed similarly. In fact, applicant's specimens suggest the same relationship between applicant and purchasers of applicant's services: "As a partner, you will participate in all of the important benefit decisions affecting your company."

Finally, applicant's argument that there will be no likelihood of confusion because the registered mark is a "tag line" that would be recognized as such, due to registrant's use of the tag line with its mark CONSOLIDATED GROUP, is irrelevant to our analysis. The purported "tag line" is a separately registered mark and our consideration of the question of likelihood of confusion is limited to comparison of the registered mark and applicant's mark, without consideration of what may or may not be used in conjunction with the registered mark in the marketplace.

In sum, notwithstanding any weakness attributable to the registered mark, applicant's mark is very similar thereto--more so than any of the marks in third-party registrations on which applicant relies--and because the respective services are overlapping in part and otherwise closely related, we conclude that there is a likelihood of confusion, mistake or deception.

Decision: The refusal of registration is affirmed.